

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Stephen C. Suffin

Serial No.: 10/697,497

Filed: 10/30/2003

Entitled: **Compositions And Methods For Treatment Of Nervous System Disorders**

Group No.: 1617

Examiner: Kim, J. M.

**REPLY BRIEF TO EXAMINER'S ANSWER
MAILED JULY 6, 2009**

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

BPAI:

Please enter the following on the record in response to the above cited Examiner's Answer mailed on July 6, 2009.

REMARKS

The Examiner maintains that the claims are obvious. However, the Examiner: a) overstates the teachings of Quessey et al.; b) fails to make a prima facie case of obviousness; and c) summarily dismisses the Applicant's Declarations providing rebuttal evidence. Each point is discussed below.

I. **The Examiner Overstates The Teachings Of Quessy et al.**

The Examiner states, for the first time, that:

... the real issue is whether the clear teaching and suggestion from Quessy et al. that these two compounds have the same therapeutic effect in the treatment of neuropathic pain ... As far as a formulation for the treatment of neuropathic pain ... oxcarbazepine is interchangeable with lamotrigine because it is fully suggested and clearly taught by Quessy et al.

Examiner's Answer pg 8 [emphasis added]. The Applicants disagree because the Examiner has made assumptions regarding Quessy's teaching that are unwarranted. The Applicants have word-searched Quessy et al. and failed to find the term "interchangeable" when comparing oxcarbazepine and lamotrigine. Further, Quessy et al. presents actual data only for lamotrigine and does not test oxcarbazepine. Clearly, the Examiner's statements would best be supported by a side-by-side experiment comparing the lamotrigine/bupropion combination with the oxcarbazepine/bupropion combination (as the Applicants' have submitted to the Examiner, *infra*). The lack of such data argues against obviousness because it is well accepted by the Patent Office that biotechnology is an unpredictable art and requires empirical data.

In contrast to the Examiner's statement, Quessy et al. simply states that lamotrigine and/or oxcarbazepine "are suitable for" use in treating neuropathic pain:

Suitable for use as Na⁺ channel blockers, referred to herein as Compound(s) (2), are lamotrigine, oxcabazepine ...

Quessy et al. ¶ [0011]. The terms 'suitable' and 'interchangeable' do not have the same meaning when it comes to biology and therapeutic treatments.

In view of the Applicants previously presented rebuttal data showing that lamotrigine and oxcarbazepine have opposite effects on the central nervous system the Examiner has not created a *prima facie* case of obviousness, even with the singular teachings of Zakrzewska et al. showing only oxcarbazepine data. The Examiner dismissed this data (*infra*).

II. The Examiner Still Fails To Make A Prima Facie Case Of Obviousness

The Examiner has tried to rebut the Applicant's arguments that Quessy et al. does not teach that lamotrigine and oxcarbazepine have the same analgesic activity and efficacy by stating that:

This is not found persuasive because ... Quessy et al. clearly named the species of norepinephrine reuptake inhibitor as bupropion and the species of a sodium channel as oxcarbazepine ...

Examiner's Answer pg 5. The argument does not comport with current judicial interpretations regarding obviousness. Merely 'naming' species does not meet the evidentiary requirement established within *KSR v Teleflex*:

Often, it will be necessary for a court to look to interrelated teachings of multiple patents ... To facilitate review, this analysis should be made explicit. See *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006) ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness").

KSR v Teleflex, 127 S. Ct. 1727, 1740 (2007) [emphasis added]. Merely pointing to single words, without the appropriate context, is wholly insufficient. As shown above, *KSR* cites *In re Kahn* to explain this requirement:

... mere identification in the prior art of each element is insufficient to defeat the patentability of the combined subject matter as a whole. [*In re Rouffet*, 149 F.3d] at 1355, 1357. ... to establish a prima facie case of obviousness ... the Board must articulate the basis ... In practice ... [t]his entails consideration of ... the "scope and content of the prior art" ...

In re Kahn 441 F.3d at 986 [emphasis added]. As such, the scope and content of Quessy et al. is insufficient to establish that lamotrigine and oxcarbazepine are, in fact, equivalent.

Further, the Examiner has not shown that Quessy et al. provides a reasonable expectation of success because (as the Examiner admits, *infra*), Quessy et al. has not provided any data showing that the combination might work:

Thus, the prior art explicitly suggested the substitution that is the difference between the claimed invention and the prior art, and presented preliminary evidence suggesting that the method could be used to make proteins.

In re O'Farrell, 853 F.2d 894, 7 USPQ2d 1673 (Fed. Cir. 1988)[emphasis added]. In fact, the Examiner has admitted that Qessy et al. contains this very deficiency:

However, Qessy et al.'s illustrated composition (example 3) uses lamotrigine with bupropion, rather than oxcarbazepine as instantly claimed.

Examiner's Answer, pg 4. Recently, the Federal Circuit has reaffirmed *O'Farrell*'s data requirement in the wake of *KSR*:

Specifically, this court observed that an obviousness finding was appropriate where the prior art “contained detailed enabling methodology for practicing the claimed invention, a suggestion to modify the prior art to practice the claimed invention, and *evidence suggesting that it would be successful.*” 853 F.2d at 902 (emphasis added).

In re Kubin, 561 F.3d 1351, 90 U.S.P.Q.2D (BNA) 1417 (Federal Circuit 2009)[underlining in original, italics added]. Therefore, in order for an obviousness rejection to stand on ‘a reasonable expectation of success’, the cited references MUST provide some evidence of the expected success, NOT just mere speculation.

The Examiner holds out Zakrzewska et al. to allegedly fulfill Qessy's deficiencies:

Further, Zakrzewska et al. teaches the advantages of oxcarbazepine having excellent therapeutic response ..

Examiner's Answer pg 6. The Examiner is respectfully requested to note that Zakrzewska's ‘excellent therapeutic response’ fails to provide any suggestion to one having ordinary skill in the art that oxcarbazepine should be combined with another drug to improve efficacy and/or broaden its clinical applicability. Consequently, like Qessy et al., Zakrzewska et al. provides no evidence (i.e., data) showing that a

bupropion/oxcarbazepine combination would be successful or even considered. The Examiner has resorted to speculative “if-then” statements that do not have evidentiary support in either cited reference and amounts to a conclusory argument. As shown above, *KSR* considers conclusory arguments as providing an insufficient basis on which to support an obviousness rejection.

III. The Examiner Improperly Dismisses The Applicants’ Declarations

The Examiner admits that the Applicants provided evidence that:

... lamotrigine and oxcarbazepine have opposite neurophysiological effects (i.e., the effects of oxcarbazepine is not predictable based upon the effects of lamotrigine), therefore, they are not interchangeable.

Examiner’s Answer, pg 7. In rebuttal of this evidence, the Examiner only states that:

... the issue is not whether the two sodium channel blockers are different ... [but]
... whether the clear teaching and suggestion from Quessy et al. that these two compound have the same therapeutic effect ...

Examiner’s Answer, pg 8. The Applicants disagree. It is clearly the issue as to whether lamotrigine and oxcarbazepine are interchangeable. The Applicants have provided clinical data showing that lamotrigine and oxcarbazepine are not necessarily interchangeable. The Examiner has not provided any rebuttal evidence (i.e., for example, by a side-by-side experiment comparing lamotrigine and oxcarbazepine) that they are interchangeable (which they are not). As detailed above, neither Quessy et al. nor Zakrzewska et al. provide any evidence that a bupropion/lamotrigine combination would be equivalent to a bupropion/oxcarbazepine combination.

The Examiner is respectfully reminded that when an Applicant rebuts obviousness (especially with a Declaration) that the examination process must “start over” wherein the Examiner is required to discuss ALL the evidence provided by the Applicant:

When an applicant timely submits evidence traversing a rejection, the examiner must reconsider the patentability of the claimed invention. The ultimate

determination of patentability must be based on consideration of the entire record, by a preponderance of evidence, with due consideration to the persuasiveness of any arguments and any secondary evidence.

In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992), and

If, after evaluating the evidence, the examiner is still not convinced that the claimed invention is patentable, the next Office action should include a statement to that effect and identify the reason(s) (e.g., evidence of commercial success not convincing, the commercial success not related to the technology, etc.).

See *Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387, 7 USPQ2d 1222 (Fed. Cir.), cert. denied, 488 U.S. 956 (1988). MPEP 716.01(d) *Weighing Objective Evidence* [emphasis added]. The Applicants see no indication that the Examiner has met this burden by maintaining a conclusory argument without presenting rebuttal evidence to the Applicant's data. Instead, the Examiner has merely dismissed the Declarations by repeating what the Examiner believes the cited art to teach, without seriously considering the scientific impact of the Applicants' data:

Appellants' apostrophe showing of whether these two agents have different neurophysiological effects due to their unrelated structural differences does not change the most relevant teaching of Quessy et al. that these two compounds have the same therapeutic effect ...

Examiner's Answer pg 8. Again, Quessy et al. does not show that therapeutic effects of lamotrigine and oxcarbazepine are the same, because Quessy et al. provides no data regarding oxcarbazepine. The Applicants' data clearly show that one having ordinary skill in the art would not consider oxcarbazepine and lamotrigine to 'necessarily' have the same effect.

The Applicants respectfully request that the Board withdraw the present rejection.

CONCLUSION

The Applicants believe that the arguments set forth above traverse the Examiner's rejections and, therefore, request that all grounds for rejection be withdrawn for the reasons set above. Should the Board believe that a telephone interview would aid in the prosecution of this application, the Applicants encourage the Board to call the undersigned collect at 781.828.9870.

Dated: September 4, 2009



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